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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,105	01/08/2001	Robert L. Pitts	TI-29117	6920

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EXAMINER

FOX, BRYAN J

ART UNIT	PAPER NUMBER
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2686

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DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,105

Applicant(s)

PITTS, ROBERT L.

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities: a period is missing at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Neustein (US005224150A).

Regarding claim 1, Neustein discloses a pager apparatus, which reads on the claimed "personal communication device", that includes an audio and/or visual indicator (see column 1, line 24), which reads on the claimed "audible signals". The pager receives a signal resulting from the call and provides an indicator associated with it [the signal] to inform the called party that he has been paged (see column 1, lines 24-26). Inherently the pager must include a receiver to receive control commands from a transmitter, as claimed. Neustein further discloses that the paging system may provide a signal to cut off operation of that pager apparatus (see column 8, lines 17-22), so inherently the pager must include circuitry to decode the control signal as claimed, and cutting off operation would read on the claimed control of at least one option.

Regarding claim 3, Neustein discloses in column 8, line 20 that the cut off signal would prevent any audio and/or visual indications, which reads on the claimed "one option which is deactivated is audible signals".

Regarding claim 5, the system disclosed by Neustein is a paging system, as can be seen in column 1, line 5.

Regarding claim 9, Neustein discloses in column 8, lines 21-22 that service could be blocked in areas such as in theaters, concert halls, etc.

Regarding claim 12, the cutoff signal disclosed by Neustein prevents any audio and/or visual indications (see column 8, line 20), which reads on the claimed silent-communications-only mode that "disables ringers and other noise making devices".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 6, 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neustein in view of Grube, et al. (US005778304A).

Regarding claim 2, Neustein does not disclose the ability to deactivate outgoing audible transmissions.

Grube, et al., however, discloses in column 2, lines 13-15, a method that controls communication based on geographic location. He further discloses that the method could limit certain types of communication services, or disable the communication unit

entirely (see column 2, lines 23-24), and disabling the unit entirely would certainly include disabling outgoing audible communications.

It would be obvious to one skilled in the art at the time of the invention to modify the paging system of Neustein to include the above disabling of outgoing communications disclosed by Grube, et al. in order to better suit a mobile phone system and lessen disturbances to others.

Regarding claim 4, Neustein does not specifically disclose that the functionality would resume upon exiting the specified area.

Grube, et al. discloses in column 3, lines 26-30 that if the communication unit is not within the predetermined geographic region, the process ends, i.e., there will be no restrictions on the communication unit's ability to access the communication services. This is interpreted to automatically allow the options that were disabled as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify the system disclosed by Neustein to include the automatic enabling of options disclosed by Grube, et al. in order to make a more user-friendly device and eliminate the need for the user to reconfigure his preferred operation mode.

Regarding claim 6, Neustein discloses in his abstract a paging system including a number of central stations, which reads on the claimed "plurality of base stations", that each base station contains a number of pager apparatus associated with it, which reads on the claimed "plurality of personal communication devices", and that each pager apparatus responds to one or more identifying numbers, which reads on the claimed capability of "radio frequency communications with a plurality of personal

communication devices.” Neustein further discloses in column 8, lines 18-20, that the system may provide a signal to all pager devices within a specific area to cut off operation of that pager device so as to prevent any audio and/or visual indications, so inherently, the pagers must have the claimed ability to detect a predetermined command (the cutoff signal) to set the respective communication device to a mode in which no audible signals are allowed. Neustein does not disclose that the pagers may be prevented from making calls.

Grube, et al. discloses a method of controlling communications based on geographic location, including prohibition of the service requested (see column 2, lines 62-63), which reads on the claimed “personal communications devices are not allowed to make or receive calls based on the lack of said ability”.

It would be obvious to one skilled in the art at the time of the invention to modify the paging system disclosed by Neustein to include the service prohibition disclosed by Grube, et al. in order to make the paging system more suitable for telephone communications.

Regarding claim 7, Neustein, discloses a local transmitter 902 (see figure 9) that would disable the pager, which reads on the claimed “low-power base station”.

Regarding claim 10, the paging system disclosed by Neustein includes a pager, which reads on the claimed “wireless communication device”, that prevents operation upon receiving a cutoff signal (see column 8, lines 17-20), so inherently includes a method for checking for the cutoff signal, which reads on the claimed known signal. The cutoff signal prevents any audio and/or visual indications (see column 8, line 20),

which reads on the claimed "silent-communications-only mode". Furthermore the cutoff signal disrupts service within a specified area (see column 8, lines 18-19), implying that upon exiting the area normal service will resume. Neustein fails to specifically disclose that in the absence of the cutoff signal, the user will be able to choose the communications mode.

Grube, et al. discloses in column 3, lines 26-30 that if the communication unit is not within the predetermined geographic region, the process ends, i.e., there will be no restrictions on the communication unit's ability to access the communication services. This would allow "a user to select the communications mode desired" as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify Neustein to include the above automatic enablement of options as disclosed by Grube in order to make the system more user friendly.

Regarding claim 11, Neustein does not disclose a mode to disable outgoing verbal communications.

Grube, et al., however, discloses a method of limiting certain types of communication services, or disable the communication unit entirely (see column 2, lines 23-24). Clearly disabling the communication unit entirely would be a mode that "disables outgoing verbal communications from said communications device" as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify the paging system disclosed by Neustein to include the above different limitations of

services, as disclosed by Grube, et al., in order to better suit a mobile phone system instead of a paging system.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neustein. Neustein discloses a paging system, which reads on the claimed "wireless communication system", that may provide a local transmitter 902 (see figure 9), which reads on the claimed "short-range base-station", that can within a specified area...cut off operation (see column 8, lines 18-19), which reads on the claimed control of "wireless mobile communications within said limited range". The local transmitter signal as described by Neustein can prevent any audio and/or visual indications (see column 8, line 20), which reads on the claimed "restricted to silent communications or blocked from all communications". Neustein fails to disclose that the service will be blocked from communications when silent mode is not equipped. Since the phone in Neustein can either cut off operation or prevent any audio or visual signals, it would be obvious to one skilled in the art at the time of the invention to modify Neustein such that the device would operate in the blocked mode if not equipped to operate in silent mode in order to ensure that the device operates only in a mode that it is equipped to.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neustein in view of Ferrara (US005422937A). Regarding claim 13, Neustein fails to disclose a system to trigger prerecorded messages.

Ferrara discloses a remotely controlled telephone operator simulator where the user is allowed operation of the touch-tone key pad...to transmit signals back to the control circuit for selecting desired response messages (see column 4, lines 3-5), which

reads on the claimed "keypad entry by the user which triggers transmission of pre-recorded messages"

It would be obvious to one skilled in the art at the time of the invention to modify the paging system of Neustein to include the above message transmission system disclosed by Ferrara in order to save the user's time to prepare a response message.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grube, et al. Regarding claim 14, Grube, et al. discloses a method of controlling communications based on geographic location that may limit certain types of communication services, or disable the communication unit entirely (see column 2, lines 23-24), which reads on the claimed "method of operating a wireless communications system, comprising the step of controlling wireless communications within a known area, wherein wireless communication devices within said known area are either block or restricted to silent communications". Grube, et al. fails to disclose that the service will be blocked from communications when silent mode is not equipped. Since the phone in Grube, et al. can either limit services or block service altogether, it would be obvious to one skilled in the art at the time of the invention to modify Grube, et al. such that the device would operate in the blocked mode if not equipped to operate in silent mode in order to ensure that the device operates only in a mode that it is equipped to.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grube, et al. in view of Stein (US005771468A). Grube, et al. fails to disclose that controlling the wireless communications would be done in more than one format on more than one channel.

Stein discloses a base station capable of communicating in a plurality of telecommunications systems where the systems operate according to different standards (see column 2, lines 28-31), which reads on the claimed "controlling communications is done in more than one format". Furthermore, since the communications are done in more than one format, they must be done in more than one channel as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify the system disclosed by Grube, et al. to include the multi-system compatibility disclosed by Stein in order to provide compatibility with multiple systems.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-0997. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



NGUYEN T. VO
PRIMARY EXAMINER

BJF